



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,851	09/28/2001	David Hugh Muir	29757/P-510	4994

4743 7590 03/30/2004

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

MARKS, CHRISTINA M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 03/30/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,851

Applicant(s)

MUIR, DAVID HUGH

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3713

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Claims 1-3 and 8-18 in Paper No. 8 is acknowledged. Applicant's arguments that claim 1 should be generic to claims 4-7 is convincing and therefore these dependent claims also will be examined upon allowance of the generic claim. The traversal is on the ground(s) that claim 1 is also generic to claim 19 and that search would not be burdensome. These arguments are not found persuasive because claim 19 is definitely a separate species, as it requires detail and limitations of graphic processing that is not specific to claim 1. Claim 19 is also of a different field of search as it requires search into claim 345 (graphic processing) that would not be required for the claim 1 which focuses on win evaluation methods; therefore, solely defined to 463.

Claims 4-7 and 19-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3713

Claims 1, 9-11, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Muir et al. (US Patent No. 6,644,664) assigned to Aristocrat Technologies.

Muir et al. discloses a gaming machine (FIG 1) with a display unit capable of generating video images (FIG 1, reference 20) with a user input device (FIG 1, reference 24.1) and a value input device (FIG 1, reference 24.2). The machine has a controller coupled to the display unit, both input devices, and comprises a processor and a memory (FIG 2). The controller receives player selected game options from the input device (Column 3). The input is the number of lines to be bet (Column 2, lines 46-51). The player can select the paylines from a number of available paylines. The available paylines can be indicative only of a first win evaluation method or a second win evaluation method (Columns 1, lines 60-67) and (Column 2, lines 1-3). The first win evaluation method is different from the second and the first is a three-dimensional win evaluation method. This is evidenced by the disclosure that a winning combination can be on the top faces of the elements only (non three-dimensional method) (Column 1, lines 60-61) or can be arranged in a zigzag manner through the three dimensional elements (three-dimensional method) (Column 2, lines 1-3). Thus the paylines chosen by the player are indicative of only one of the two possible types. In understanding the disclosure of the paylines, FIG 3 provides a better understanding. By viewing the possible disclosed paylines, a non-three dimensional only would be the payline disclosed to be straight across any faces, wherein the disclosed payline of zigzagging through the elements would be indicative of a three-dimensional win evaluation, different from the other evaluation method.

The controller allows a person to place a wager (Column 3, lines 4-10) and is programmed to cause a three-dimensional video image to be generated on the display unit wherein the three-dimensional video image represents a casino game (FIG 3). The controller is also programmed to perform a first win evaluation method to determine a payout associated

Art Unit: 3713

with an outcome of the casino game if the player chose a payline associated with the game option of the first win evaluation method (Column 3, lines 33-46).

Regarding claims 9-11, Muir et al. disclose a win evaluation method that combines a plurality of individual layer evaluations, a Z-layer interaction, and an n-layer evaluation as zigzags are taken into account (Column 3, lines 55-60). The payline can exist through the elements, therefore going through different layers to encompass different dimensions of the elements.

Regarding claim 13, the controller determines the outcome based on the number of play layers associated with the selection made by the player (Column 3, lines 57-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 8, 12, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al. (US Patent No. 6,644,664).

What Muir et al. disclose has been discussed above and is incorporated herein.

Art Unit: 3713

Regarding claims 2 and 12, the incorporation of multiple pay tables would have been a non-inventive step to the disclosure of Muir et al. It is known in the art to use more than a single payable in a gaming machine, such as for when different amount of bets are used, thus based on player-selected option. It would have been obvious to one of ordinary skill in the art to incorporate such a feature into Muir et al. to award players with higher wins, as is known in the art, when they wager greater amounts. Motivations for doing so would lie with the wants and desires for the designer in applying the payout percentages. Progressive award tables are also known and using the most difficult combination possible to extend the progressive award is essential to the feature working properly. Thus, using a three-dimensional win evaluation with such wherein the most difficult combination is represented, as a three-dimensional combination would be obvious to a skilled artisan. One would be motivated to incorporate the progressive features into the Muir et al. system to award the players greater prizes, thus attracting and retaining more players to the game. This would cause greater revenue to be generated for the casino and increase attraction to players.

Regarding claim 3, the display of the strips would be obvious to change based upon the disclosure of Muir et al. In FIG 1, the display is shown in only one dimension as opposed to FIGS 3-4 wherein three dimensions are chosen. Based on this disclosure, a skilled artisan would be motivated to alternate the views of the device based upon wager selections. One would be motivated to do this to best serve the player as showing all three dimensions would be confusing to a player who had not wagered on such and might create tension and false indication of wins. Thus, showing only the properly wagered sections would help to alleviate this problem and a skilled artisan would be motivated to do so in order to accommodate the player needs.

Art Unit: 3713

Regarding claim 8, Muir et al. discloses multiple symbols connected to other symbols and does not choose to disclose the symbols within each other. However, the graphic portrayal of information presentation is a design choice obvious to one of ordinary skill in the art. One of ordinary skill in the art would be motivated by the needs and desires for their system. The display would be the choice of the designer wherein the design chosen would be motivated by the presentation effect desired by the game designer. Displaying the symbols within each other as opposed to side by side in three dimensional form would be an obvious alternative design choice as both would serve to present the same information to the user and would still allow the game to function as disclosed and thus would be obvious to a skilled artisan.

Regarding claims 14 and 15, Muir et al. does not explicitly disclose that the controller is programmed to check the player selection for allowability or sufficient credits; however, it is notoriously well known in the art that gaming machines are more than capable of doing so. Therefore, it would be obvious to one of ordinary skill in the art that the controller of Muir et al. would check to make sure the game options are properly funded and allowed. One would be motivated to incorporate this step in order to make sure the player properly follows all betting regulations (i.e. order of betting on paylines, etc.) and pays for all paylines as well as to inform the player that there is not sufficient bets placed to play their selection options or that they cannot bet on certain lines before other lines, thus ensuring player understanding as well as proper payment for all lines. Such features are friendly to the user as they work to ensure the player is able to make the best they desire while following the designer defined rules for the game.

Regarding claims 16 and 17, Muir et al. do not explicitly disclose a network of gaming apparatus. However, it would be obvious to a skilled artisan to make this incorporation as doing so is notoriously well known in the art. The artisan would be motivated to network the machines

Art Unit: 3713

for a number of reasons based upon the designer's wants and desires for the system. Such motivation for using a network includes enhanced bonuses, progressive opportunities, cooperative play and higher jackpots, all known to enhance user play as well as attractiveness. Usage of the Internet is an obvious means to connect the games, as it is a well-known network platform with motivations to use being its availability, cost effectiveness, ease of use, and ability to attract a large number of users familiar with the platform.

Regarding claim 18, Muir et al. disclose a number of games playable on the format from poker to a dice game. The incorporation of slots, blackjack, keno, and bingo as well as their associated indicia would be an obvious design alternative. The type of game portrayed would be a non-critical design choice. The designer would be motivated to adapt the game of choice to fit their needs and desires for the game. All of the claimed formats are known in the video art and the choice of such would be based upon the wants and needs of the designer, who is motivated based upon factors to their own choosing as required by the needs and desires of their client base.

Muir et al. disclose a game that involves the usage of a number of different types of paylines. The critical feature involves three-dimensional incorporation among the symbols to offer the player more than one type of paylines. The incorporation of different pay-tables, progressive pay-tables, ways to display the information and a network would be non-inventive steps all within the capabilities of an ordinary artisan. As stated above, the incorporation and alteration of such features are design choices motivated by the wants, needs, and desires of the designer for the gaming system. Each designer would be motivated by their own specification and would understand how to change and tweak certain features for the system. The features are non-critical to the overall teachings of Muir et al. relating to providing the player with two

Art Unit: 3713

different types of paylines, both three-dimensional and non three-dimensional based on the player's input.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Publication 2004/0009803: Gaming system with three-dimensional and non-three dimensional paylines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm

cmm
March 23, 2004

T. Walberg

Teresa Walberg
Supervisory Patent Examiner
Group 3700